

## **Remarks/Arguments**

This Response is provided in response to the Non-Final Office Action mailed May 29, 2008, in which the Examiner rejected claim 15 under 35 U.S.C. §101 as not being limited to statutory subject matter, claims 1-4, 15-17, and 21 under 35 U.S.C. §102(e) as being anticipated over the prior art, and claims 5-9, 10, 11, 12, 13, 14, 17-20, and 22-29 under 35 U.S.C. §103(a) as being unpatentable over prior art. In view of the present remarks, Applicants believe that claims 1-29 are presently in condition for allowance.

### **Rejection of Claims Under 35 U.S.C. §101**

The Examiner rejected claim 15 as not being drawn to statutory subject matter. Specifically, the Examiner reasoned that claim 15 is not limited to tangible embodiments, and, as such, is not limited to statutory subject matter. Applicants respectfully traverse this rejection.

### ***Legal Precedent***

Statutory subject matter, as set forth in Section 101, includes "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." 35 U.S.C. § 101. As such, according to the Supreme Court, congress intended statutory subject matter to "include anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09; 206 U.S.P.Q. 193, 197 (1980). In particular, it is clear that claims directed to products, apparatuses and devices are clearly statutorily patentable. As set forth in M.P.E.P. § 2106(II)(c), "For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures, or compositions of matter."

Additionally, the Federal Circuit has developed a test which may be used to determine if a claim recites statutory subject matter, namely whether the claim produces a "useful, concrete, and tangible result." *In re Alappat*, 31 U.S.P.Q.2d 1545, 1557 (Fed. Cir. 1994) (*en banc*). The Federal Circuit has stated "the dispositive inquiry is whether the claim *as a whole* is directed to statutory subject matter." *Id.* The Federal Circuit elaborated

by holding that one must look to “the essential characteristics of the subject matter, in particular, its practical utility.” *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 U.S.P.Q.2d 1596, 1602 (Fed. Cir. 1998). Moreover, the Federal Circuit has stated “the *Alappat* inquiry simply requires an examination of the contested claims to see if the claimed subject matter *as a whole* is a disembodied mathematical concept representing nothing more than a ‘law of nature’ or an ‘abstract idea,’ or if the mathematical concept has been reduced to *some practical application rendering it ‘useful’*.” *AT&T Corp. v. Excel Communications, Inc.*, 50 U.S.P.Q.2d 1447, 1451 (Fed. Cir. 1999) (emphasis added). In other words, “Is an actual process machine, manufacture, or composition of matter being claimed in accordance with 35 U.S.C. §101, or is the claim drawn to an abstraction?” Therefore, if a claim, read as a whole and in light of the specification, produces any useful, concrete, and tangible result, the claim meets the statutory requirements of Section 101. *See id.*

***The specification describes machine readable mediums, all of which fit into the allowed classes of statutory subject matter for a claim.***

In particular, the Examiner cited paragraph 1, page 8 of the specification which recites, *inter alia*:

As used herein and contemplated by the invention, computer-readable medium is not limited to memory and storage devices; rather computer-readable medium is an extensible term including other storage and signaling mechanisms including interfaces and devices such as network interface cards and buffers therein, as well as any communications device and signals received and transmitted, and other current and evolving technologies that a computerized system can interpret, receive, and/or transmit.

The Examiner read “signaling mechanisms” and “signals received and transmitted” as non-statutory classes of a computer-readable medium. *See* Office Action, page 3. However, a signaling mechanism is a physical device, and as such, qualifies at least as a

machine for § 101 purposes. Because a machine is a class of statutory subject matter under § 101, signaling mechanisms, as described in the specification, are drawn to statutory subject matter.

Furthermore, the Examiner has misread the specification in suggesting that “signals received and transmitted” is directed to non-statutory subject matter. This portion of the specification is correctly read to be “as well as any communications device and signals received and transmitted.” This must be the proper reading because the entire clause is set apart by commas. As such, it must be read as a whole.

Accordingly, when the aforementioned clause is read as a whole, the signals received and transmitted are described only in conjunction with a communications device, *i.e.*, a machine. Thus, this section of the specification details the operation of a machine, specifically a communications device that receives and transmits signals. As described above, a machine is a proper category of statutory matter. Thus, the communications device and signals received and transmitted are drawn to statutory subject matter. Therefore, the specification supports only statutory classes of machine readable mediums. Accordingly, claim 15 is limited to tangible embodiments, and, as such, is limited to statutory subject matter. For at least these reasons, among others, Applicants respectfully request withdrawal of the rejection of claim 15 under 35 U.S.C. § 101, and passage of the same to allowance.

#### **Rejection of Claims Under 35 U.S.C. §102(e)**

The Examiner rejected claims 1-4, 15-17 and 21 under 35 U.S.C. §102(e) as being anticipated by United States Patent No. 5,627,766 issued to Paul A. Beaven, May 6, 1997 (hereinafter “Beaven”). Applicants respectfully traverse this rejection.

#### ***Legal Precedent***

Anticipation means a lack of novelty, and is a question of fact which is reviewed by the reviewing court using a substantial evidence standard. *Brown v. 3M*, 60 USPQ2d 1375

(Fed. Cir. 2001); *Baxter Int'l, Inc. v. McGaw, Inc.*, 47 USPQ2d 1225 (Fed. Cir. 1998). To anticipate a claim, every limitation of the claim must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 USPQ2d 1286 (Fed. Cir. 2001). *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831 (2002). Each such limitation must be found either expressly or inherently in the prior art reference. *Schering Corporation v. Geneva Pharmaceuticals, Inc.*, 02-1540, Decided August 1, 2003 (Fed. Cir. 2003). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

***The cited reference fails to show processor initiated simultaneous execution of the first and the second non-sequential tests of a first type over two paths as recited by independent claims 1, 15, 16, and 21.***

Current claims 1, 15, 16, and 21 recite conducting a first performance test of a first type over a first path of the plurality of paths between a first and second device; conducting a second performance test of the first type over a second path of the plurality of paths between the first and second device; and wherein a processor initiates the simultaneous execution of the first and the second non-sequential performance tests.

The Examiner has relied on Beaven to anticipate the aforementioned claim recitations. However, unlike the language recited in claims 1, 15, 16, and 21, Beaven fails to describe simultaneous execution of a test of a first type over a first and second path. Beaven describes monitoring a network from a single point of control (POC). Beaven, col. 2, lines 40-44. This POC transmits a test to a *single* node test program entity (NTP). *Id* at col. 2, lines 45-49; col. 3, lines 4-7. The single NTP then transmits a reply message to the POC and forwards the original transmission from the POC to other NTPs. *Id* at col. 2, lines 50-54; col. 3, lines 10-16. These NTPs then transmit reply messages to the POC while forwarding on the original transmission from the POC to subsequent NTPs. *Id* at 55-59; col. 3, lines 10-16. The key aspect of this system is that the POC initially injects a *single test message* into the network as a performance test. Beaven, col. 4, lines 5-8. Thus, even

though Beaven discusses simultaneous monitoring of multiple connections between two nodes (col. 4, lines 8-11), the simultaneous running of the tests is initiated “at *different nodes*.” Beaven, col. 4, lines 11-12 (emphasis added), rather than being initiated simultaneously from a processor.

The Examiner stated “Beaven discloses program (processor) initiated simultaneous execution of performance type tests over multiple or alternate paths between the two (a first and second) network-connected nodes.” *See* Office Action, page 4. What is notable about this portion of the rejection is that the Examiner has failed to cite any portion of Beaven as teaching these recitations. This is unsurprising, since no portion of Beaven describes these recitations. Indeed, the Examiner will continue to be unable to cite any portion of Beaven for processor initiated simultaneous execution of performance tests over alternate paths between a first and second device because Beaven is silent as to these elements.

In other portions of the rejection, the Examiner attempted to show that Beaven, in col. 4, lines 8-13, describes simultaneous execution of performance tests. However, this section of Beaven describes, at best, simultaneous *monitoring* of multiple connections between two nodes. Simultaneous *monitoring* of multiple nodes does anticipate simultaneous *execution* of performance. For example, a first test may be initiated at some first time T1, and a second test may be initiated at a later second time T2. Subsequent to T2, simultaneous *monitoring* of the tests may occur, but this simultaneous *monitoring* does not equate with simultaneous *execution* of the tests.

Indeed, Beaven, at best, describes *initiating* a test by sending a message to a first NTP. This involves initiating a *single message* along a *single path*, namely the path between the POC and the first NTP. This cannot read on conducting a *first test* of a first type along a *first path*, and a *second test* of a first type along a *second path* because there is only *one test initiated along a single path* in Beaven. Furthermore, since the POC initiates only a *single message*, Beaven cannot anticipate a processor initiating the *simultaneous execution* of non-sequential tests. Only one test is initiated by the POC of Beaven. Thus,

although Beaven may describe initiating a *single* test that may be dispersed into multiple tests after being received by the initial NTP, only simultaneous *monitoring* of the dispersed tests by the POC is described by Beaven, not *simultaneous execution* of two *processor initiated* tests as recited by independent claims 1, 15, 16, and 21.

Accordingly, Beaven fails to anticipate every recitation of independent claims 1, 15, 16, and 21. Furthermore, based at least upon their dependency to claims 1, 16, and 21, claims 2-14, 17-20, and 22-29 are not anticipated by Beaven. For at least these reasons among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102, and passage of claims 1-29 to allowance.

#### **Rejection of Claims Under 35 U.S.C. §103(a)**

The Examiner rejected claims 5-9, 13, 17-20, and 22-29 under 35 U.S.C. §103(a) as being unpatentable over Beaven in view of United States Patent No. 6,763,380 issued to Kim Irvin Mayton, et al., July 13, 2004 (hereinafter “Mayton”). The Examiner further rejected claims 10, 11, and 14 under 35 U.S.C. §103(a) as being unpatentable over Beaven in view of Mayton and further in view of United States Patent Number 6,360,268, issued to Stephen Silva, et al., March 19, 2002 (hereinafter “Silva”). Finally, the Examiner rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Beaven in view of Mayton and further in view of United States Publication Number 2003/0036865, inventor ZhangQing Zhuo, et al., February 20, 2003 (hereinafter “Zhou”). Applicants respectfully traverse these rejections.

#### ***Legal Precedent***

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The Supreme Court has recently stated that, “[A] patent composed of several elements is not proved obvious merely by demonstrating

that each of its elements was, independently, known in the prior art,” and that “A court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731.

***The cited references, taken alone or in combination, fail to teach or suggest features recited by claims 5-9, 13, 17-20, and 22-29.***

Claims 5-9, 13, 17-20, and 22-29 depend from independent claims 1, 16, and 21 and include all recitations of the independent claims. As discussed above in the section titled “Rejection of Claims Under 35 U.S.C. §102(e),” Beaven fails to teach or suggest the recitations of independent claims 1, 16, and 21. Mayton supplies neither the missing elements nor a showing for the combinability of the two references to teach the recitations of claims 1, 16, or 21. Due to at least the dependencies of claims 5-9, 13, 17-20, and 22-29 on independent claims 1, 16, and 21, the cited references, taken alone or in hypothetical combination, cannot render obvious claims 5-9, 13, 17-20, and 22-29. For at least these reasons, as well as for reasons previously presented, Applicants request withdrawal of the rejection of claims 5-9, 13, 17-20, and 22-29 under 35 U.S.C. §103(a), and passage of same to allowance.

***The cited references, taken alone or in combination, fail to teach or suggest features recited by claim 10, 11, and 14.***

As discussed above in the section titled “Rejection of Claims Under 35 U.S.C. §102(e),” neither Beaven nor Mayton teaches or suggests the recitations of claim 1. Silva supplies neither the missing elements nor a showing for the combinability of the references. Thus, neither Beaven, Mayton, nor Silva, taken alone or in combination, teach the above recitations of claim 1. Due to at least the dependency of claims 10, 11, and 14 on claim 1, the cited references, taken alone or in hypothetical combination, cannot render obvious claims 10, 11, and 14. For at least these reasons, as well as for reasons previously presented, Applicants request withdrawal of the rejection of claims 10, 11, and 14 under 35 U.S.C. §103(a), and passage of same to allowance.

*The cited references, taken alone or in combination, fail to teach or suggest features recited by claim 12.*

As discussed above, neither Beaven nor Mayton teach or suggest the amended recitations of claim 1. Zhuo supplies neither the missing elements nor a showing for the combinability of the two references. Thus, neither Beaven, Mayton, nor Zhuo, taken alone or in combination, teach the above recitations of claim 1. Due to at least the dependency of claim 12 on claim 1, the cited references, taken alone or in hypothetical combination, cannot render obvious claim 12. For at least these reasons, as well as for reasons previously presented, Applicants request withdrawal of the rejection of claim 12 under 35 U.S.C. §103(a), and passage of same to allowance.

**Conclusion**

Applicants respectfully submit that all pending claims should be in condition for allowance. This Response is intended to be a complete response to the Non-Final Office Action mailed May 29, 2008.

However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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